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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/506,215	02/17/2000	Shimada Naohiro	P/126-182	7056

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STEVEN I. WEISBURD, ESQ.  
DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP  
1177 AVENUE OF THE AMERICAS - 41st FLOOR  
NEW YORK, NY 10036-2714

EXAMINER

PRIETO, BEATRIZ

ART UNIT	PAPER NUMBER
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2142

DATE MAILED: 11/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/506,215

Applicant(s)

NAOHIRO, SHIMADA

Examiner

B. Prieto

Art Unit

2142

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 27 October 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see supplemental.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.

Claim(s) objected to: none.

Claim(s) rejected: 1, 2, 15 and 16.

Claim(s) withdrawn from consideration: none.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

MARC D. THOMPSON  
MARC THOMPSON  
PRIMARY EXAMINER

### Supplemental Advisory

1. This communication is in response to request for reconsideration filed 10/27/03, claims 12 AND 15-16 remain pending.

2. Applicant argues that final office action is premature because significant changes to the portions of the prior art relied on where made, therefore these changes are “*new grounds of rejection*”.

In response to this argument, it is noted that on office action mailed 4/23/03 and office action mailed 8/13/03, claims 1-2 and 15-16 were rejected under U.S.C. §103 over Kudo (6,256,326) in view of Ellis (6,256,292). This office action contains a complete statement of grounds of rejection, the final office action refers to the same statement, therefore the grounds of rejection have not change, finality is proper (see MPEP §706.07 & 2271).

3. Applicant argues that prior art of record does not teach claim invention because the cited portion do not represent the “actual language” of claim, therefore the office has failed to establish prima facie case of obviousness.

In response to applicant’s argument, it is noted according to the MPEP, Office personnel must rely on the applicant’s disclosure to properly determine the meaning of terms used in the claims. *Markman v. Westview Instruments*, 52 F.3d 967, 980, 34 USPQ2d 1321, 1330 (Fed. Cir.) (en banc), aff’d, U.S. , 116 S. Ct. 1384 (1996). An applicant is entitled to be his or her own *lexicographer*, and in many instances will provide an explicit definition for certain terms used in the claims. Where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim. *Toro Co. v. White Consolidated Industries Inc.*, 199 F.3d 1295, 1301, 53 USPQ2d 1065, 1069 (Fed. Cir. 1999) (meaning of words used in a claim is not construed in a “lexicographic vacuum, but in the context of the specification and drawings.”). Claims and disclosures are not to be evaluated in a vacuum. Office personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997 see MPEP §2111).

Specifically in this case, the claimed term “first layer”, pertains to SDH path lines crossing multiple points also called nodes (see page 10-11), where layers relate to routing operations (see page 2). Upper one of the SDH paths 20 (marked as “first layer” on Fig. 4) does not carry any packet to be dropped at the cut-through node, the SDH path 20 is not terminated and packets on the SDH path 20 are made to pass through to a next node (cut-through 1). The termination of the SDH path (for example,

VT1.5) (marked "second layer" on Fig. 4) but also the operation in a "second layer 23" or a "third layer 24" (Fig. 5) become unnecessary (see page 12). The private line (x) SDH path 10 (on FIG. 5) has a throughput of  $n \times \text{VT1.5} (n)$  ("virtual tributary level") being an arbitrary natural number corresponding to a necessary band) (marked as "second layer" on Fig. 5). For each unit of  $n \times \text{VT1.5}$ , the private line (y) SDH path 11 or the private line (z) SDH path 12 is subjected to "cut-through (pass-through) 1". In this case, it is only necessary to terminate a section overhead (SOH), a line overhead (LOH), and a path overhead (POH) as depicted by a reference numeral 25 (marked as "first layer" on Fig. 5). Termination of VT1.5 is unnecessary (see page 13). Therefore, the term layers seem to relate to SDH levels or routing functions or transferring functions, broadly speaking.

Specifically in claim 1, it is noted that the terms "first, second and third layer" are not explicitly defined (see MPEP §2111). Nothing in claim 1 defines what is a first layer, what is a second layer nor what is a third layer.

Claim limitation recites, the first layer transmitting the packet to the third layer through the second layer when the first layer judges that the packet is to be dropped at the node.

a first layer (layers HPT through PPI of Fig. 6), a second layer (layers MSA of Fig. 6) and a third layer (layers MSP to SPI of Figure 6); said first layer determines whether the packet is to be transmitted to another identified node via an established data link (col 6/lines 39-45, col 8/lines 17-22, transmission to the next node or adjacent node col 22/lines 17-26) and transmitting data (packet) to said third layer through said second layer when determine that the packet is to be forwarded to another node (Fig. 12, col 8/lines 4-15, 33-42).

Argument that "the actual and complete language of claim 1" has not been considered is not persuasive.

MARC D. THOMPSON  
MDT  
PRIMARY EXAMINER

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prieto, B. whose telephone number is (703) 305-0750. The Examiner can normally be reached on Monday-Friday from 6:00 to 3:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's Supervisor, David Wiley can be reached on (703) 308-5221. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800/4700.

Any response to this action should be mailed to:  
Commissioner of Patents and Trademarks  
Washington, D.C. 20231


or faxed to the Central Fax Office:

(703) 872-9306, for Official communications and entry;

Or Telephone:

(703) 306-5631 for TC 2100 Customer Service Office.

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington VA, Fourth Floor (Receptionist), further ensuring that a receipt is provided stamped "TC 2100".

  
B. Prieto  
TC 2100  
Patent Examiner  
November 11, 2003

MARC D. THOMPSON  
MARC THOMPSON  
PRIMARY EXAMINER